

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 29, 2005 ("*Office Action*"). Claims 1-25, 46-70, and 88-92 were pending in the Application and stand rejected. Applicants respectfully request reconsideration and favorable action in this case.

Claim Rejections Under 35 U.S.C. § 103(a)

A. Claims 1-25, 46-70, and 88-92 are Patentable Over the Combination of *Myers* and *Sasuta*.

The Examiner rejects Claims 1 and 46 under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,862,490 to Sasuta et al. ("*Sasuta*") in view of U.S. Patent No. 6,618,594 to Myers et al. ("*Myers*"). The Examiner rejects all remaining claims under 35 U.S.C. 103(a) as unpatentable over the combination of *Sasuta*, *Myers*, and at least one other reference, including: (a) U.S. Patent No. 5,301,359 to Van den Heuvel et al. ("*Van den Heuvel*"); (b) U.S. Patent No. 6,064,972 to Jankowitz ("*Jankowitz*"); (c) U.S. Patent No. 5,961,569 to Craport et al. ("*Craport*"); and (d) U.S. Patent No. 6,424,646 to Gerszberg et al. ("*Gerszberg*").

Applicants respectfully traverse these rejections and submit that *Sasuta* and *Myers*, whether taken alone or in combination, fail to teach or suggest all limitations of the claims. Secondly, *Myers* teaches away from the claims, and, thus, the use of *Myers* under § 103 is improper. Finally, the other cited references fail to teach or suggest the claim limitations omitted by *Sasuta* and *Myers*.

For example, take Applicants' independent Claim 1, which recites:

A method for brokering resources of a wireless communications network, comprising:

providing a service interface allowing a user of a remote communications device to select one or more geographic regions for which the user desires wireless service coverage for the remote communications device;

receiving at a centralized brokerage manager via the service interface a request from the user for a wireless service at a particular geographic region selected by the user via the service interface;

selectively determining an availability of the wireless service for at least two service providers available at the selected geographic region based on the request;

generating a first response to the request based on the availability of the wireless service at the selected geographic region, the first response including one or more terms for the wireless service including at least one option between the at least two service providers;

communicating the first response to the remote communications device; and

receiving a second response to the first response, the second response selecting at least one of the at least two service providers to provide the wireless service.

1. *Myers* and *Sasuta* fail to teach or suggest all limitations of the claims.

Claim 1 requires “generating a first response to the request based on the availability of the wireless service at the selected geographic region, the first response including . . . at least one option between the at least two service providers.” Applicants respectfully submit that *Sasuta* and *Myers*, whether taken alone or in combination, fail to teach or suggest these aspects of the claim.

Sasuta teaches a system for providing communication services to communication units roaming in a coverage area. (col. 2, lines 35-38 and 57-62). The communication units of *Sasuta* select services based on service provider information maintained in a central service directory. However, *Sasuta* does not teach or suggest that the communication unit requests “a wireless service at a particular geographic region” or that “a first response to the request [is generated] based on the availability of the wireless service at the selected geographic region, the first response including . . . at least one option between the at least two service providers,” as required by Claim 1 (emphasis added).

Additionally, *Myers* fails to teach or suggest these limitations. *Myers* teaches a method for a mobile user terminal to define a user zone in a wireless communication system. (Abstract). After defining the user zone with a graphical user interface, the terminal communicates the desired user zone, service type, and duration to one particular service provider. (col. 4, lines 35-40).

Myers does not teach or suggest “generating a first response to the request based on the availability of the wireless service at the selected geographic region, the first response including . . . at least one option between the at least two service providers.” Instead, *Myers* discloses a communication exchange between a terminal and a single service provider. In order to access multiple service providers, *Myers* specifies that the terminal can “transmit[]

the desired user zone and communication service options to all of the wireless service providers in the transmission area,” and “[t]he wireless service providers, in turn, transmit a response to the user terminal.” (col. 4, lines 11-15; emphasis added). Because each response comes from an individual service provider, *Myers* fails to teach a response that includes “at least one option between the at least two service providers.”

Therefore, *Sasuta* and *Myers*, whether taken alone or in combination, do not teach or suggest “generating a first response to the request based on the availability of the wireless service at the selected geographic region, the first response including . . . at least one option between the at least two service providers,” as required by Claim 1. Independent Claims 46 and 88 include limitations that, for substantially similar reasons, are not taught or suggested by the references. Because *Sasuta* and *Myers*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 1, 46 and 88, Applicants respectfully request reconsideration and allowance of independent Claims 1, 46, and 88, and their respective dependent claims.

2. *Myers* teaches away from the claims.

Applicants respectfully submit that *Myers* teaches away from the claims, and, thus, the use of *Myers* under § 103 is improper. Among other aspects, *Myers* teaches away from “generating a first response to the request based on the availability of the wireless service at the selected geographic region, the first response including . . . at least one option between the at least two service providers,” as required by Claim 1.

After disclosing the method by which a user terminal contacts a single service provider “to reserve system capacity and to subscribe to features,” *Myers* explains how a user terminal might contact “multiple wireless service providers.” (col. 4, lines 1-9). *Myers* specifies that, in such a case, the user terminal “transmits the desired user zone and communication service options to all of the wireless service providers in the transmission area. The wireless providers, in turn, transmit a response to the user terminal 24.” (col. 4, lines 7-15; emphasis added). The user terminal, thus, interacts separately with each wireless service provider. This teaches away from “a centralized brokerage manager” receiving a request from a terminal and a “first response including . . . at least one option between the at least two service providers.”

Applicants thus respectfully submit that *Myers* teaches away from Claim 1. Also, *Myers* teaches away from independent Claims 46 and 88 for substantially similar reasons. Because *Myers* teaches away from limitations of Claims 1, 46 and 88, the use of *Myers* under § 103 is improper. M.P.E.P. § 2145. For at least this reason, Applicants respectfully request reconsideration and allowance of independent Claims 1, 46, and 88, and their respective dependent claims.

3. Each of the other cited references fails to teach or suggest the claim limitations not taught by *Sasuta* and *Myers*.

The other cited references, *Van den Heuvel*, *Jankowitz*, *Craport*, and *Gerszberg*, fail to teach or suggest the claim limitations omitted by *Sasuta* and *Myers*, particularly “generating a first response to the request based on the availability of the wireless service at the selected geographic region, the first response including . . . at least one option between the at least two service providers.”

Van den Heuvel teaches a bulletin board communication resource that “provides a message to communication units regarding available communication systems in a particular geographic area.” (Abstract). The bulletin board resource allows a communication unit to register with one or more communication systems selected by the communication unit. (Abstract). While the geographic location of a communication unit may affect its ability to access different systems (col. 2, lines 29-35), *Van den Heuvel* does not teach or suggest generating a “response based on the availability of the wireless service at the selected geographic region.”

Also, *Jankowitz*, *Craport*, and *Gerszberg* do not teach or suggest, “generating a first response to the request based on the availability of the wireless service at the selected geographic region, the first response including . . . at least one option between the at least two service providers,” as required by Claim 1.

Therefore, *Van den Heuvel*, *Jankowitz*, *Craport*, and *Gerszberg*, whether taken alone or in combination, fail to teach or suggest the limitations of Claim 1 that *Sasuta* and *Myers* fail to teach or suggest. Independent Claims 46 and 88 include limitations that, for substantially similar reasons, are not taught or suggested by any of the references. Because all cited references, whether taken alone or in combination, fail to teach or suggest all

limitations of Claims 1, 46, and 88, Applicants respectfully request reconsideration and allowance of independent Claims 1, 46, and 88, and their respective dependent claims.

B. The Proposed Combination of References Would Impermissibly Change the Principle of Operation of the References.

In addition, Applicants respectfully submit that the Claims 1-25, 46-70, and 88-92 are patentable over the cited references because the proposed combination of references would impermissibly change the principle of operation of the references. To render the claims *prima facie* obvious, a proposed modification or combination of references must not change the principle of operation of the reference or references being modified. M.P.E.P. §2143.01.

Each rejection relies at least in part on a proposed combination of *Sasuta* and *Myers*. However, the proposed modification of *Sasuta* based on *Myers* would improperly change *Sasuta*'s principle of operation. The operation of *Sasuta* requires the communication unit to catalogue the service attributes for each of the plurality of service providers so that a determination can be made as to which service providers are necessary to meet their service requirements. (col. 2, lines 42-46). This is facilitated by a central service directory, which stores service provider information regarding available services, active communications, and present affiliations. (col. 3, lines 21-27). The communication unit, after cataloging the service attributes for each of the service providers, selects a service provider for each service required. (col. 5, lines 36-47). Modifying *Sasuta* to allow a communication unit to define its own temporary user zone, as taught by *Myers*, would not only change the principle of operation disclosed by *Sasuta*, but the efficiencies inherent in *Sasuta* would be lost because the central service directory would need to store information for a multitude of discrete locations or would need to process the specific geographic area selected by the user. *Sasuta* identifies advantages of the invention and specifies that the centralized configuration disclosed is beneficial because it decreases the time required for the communication units to determine the appropriate service provider. (col. 3, lines 34-44). The combination of *Sasuta* and *Myers* would increase the time required to access information in the central service directory. Thus, Applicants respectfully submit that the proposed modification is improper.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 1-25, 46-70, and 88-92 are allowable over the cited references.

C. There is No Teaching, Suggestion, or Motivation to Combine or Modify the Teachings of the References.

Furthermore, Applicants maintain their previously presented arguments regarding the lack of teaching, suggestion, or motivation to combine or modify the references to teach or suggest Applicants' claimed subject matter.

Applicants respectfully submit that Claims 1-25, 46-70, and 88-92 are patentable over the cited references because there is no teaching, suggestion, or motivation to combine or modify the teachings of the references either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Moreover, the *Office Action* fails to point to any evidence sufficient to show a *prima facie* case of obviousness.

The M.P.E.P. sets forth a strict legal standard for combining or modifying references. According to the M.P.E.P., "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. "The mere fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination" or modification. *Id.* (emphasis in original).

Governing Federal Circuit case law makes this strict legal standard even clearer. According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation . . . is an 'essential component of an obviousness holding.'" *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)). Furthermore, while "evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved, . . . [t]he range of sources available . . . does not diminish the requirement for

actual evidence.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Thus, it is a factual question that cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). Indeed, the factual inquiry whether to combine or modify references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001).

1. Claims 1 and 46.

The Examiner rejects Claims 1 and 46 under 35 U.S.C. 103(a) as unpatentable over *Sasuta* in view of *Myers*.

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Sasuta* and *Myers*. Instead, the *Office Action* has merely stated that the teachings of one reference would improve the teachings of another reference. With regard to independent Claim 1, the *Office Action* states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of *Myers* to said method of *Sasuta* in order to better avoid higher charges for communications in certain geographic areas.

Office Action, page 3.

Applicants respectfully submit that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the *Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 1 and 46 are allowable over the cited references.

2. Claims 2-15, 19, 20, 24, 25, 48-61, 65, 66, 69, and 70.

The Examiner rejects Claims 2-15, 19, 20, 24, 25, 48-61, 65, 66, 69, and 70 under 35 U.S.C. 103(a) as unpatentable over *Sasuta* and *Myers* in view of *Van den Heuvel*.

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Sasuta*, *Myers*, and *Van den Heuvel*. Instead, the *Office Action* has merely stated that the teachings of one reference would improve the teachings of another reference, stating:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Van den Heuvel to said method of Sasuta in order to better offer alternate wireless services based on geographic region.

Office Action, page 4.

Applicants respectfully submit that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the *Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 2-15, 19, 20, 24, 25, 48-61, 65, 66, 69, and 70 are allowable over the cited references.

3. Claims 88-90.

The Examiner rejects Claims 88-90 under 35 U.S.C. 103(a) as unpatentable over *Van den Heuvel* in view of *Sasuta* and *Myers*.

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Van den Heuvel*, *Sasuta*, and *Myers*. Instead, the *Office Action* has merely stated that the teachings of one reference would improve the teachings of another reference. With regard to independent Claim 88 the *Office Action* first states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Sasuta to said method of Van den Heuvel in order to reduce multiple requests being made before access to a wireless service is gained.

Office Action, page 8. Then, the *Office Action* states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Myers to said method of Sasuta in order to better avoid higher charges for communications in certain geographic areas.

Office Action, page 9.

Applicants respectfully submit that these statements do not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. These statements represent the subjective belief of the Examiner, do not point to any known authority, and therefore are not based on objective evidence of record. Thus, the *Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 88-90 are allowable over the cited references.

4. Claims 16-18, 21, 62-64, 67, and 91.

The Examiner rejects Claims 16-18, 21, 62-64, 67, and 91 under 35 U.S.C. 103(a) as unpatentable over *Van den Heuvel*, *Myers*, and *Sasuta* in view of *Jankowitz*.

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Van den Heuvel*, *Myers*, *Sasuta*, and *Jankowitz*. Instead, the *Office Action* has merely stated that the teachings of one reference would improve the teachings of another reference, stating:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Jankowitz to said method of Van den Heuvel in

order to expand the number of resources available to a user to provide the best service.

Office Action, page 9-10.

Applicants respectfully submit that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the *Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 16-18, 21, 62-64, 67, and 91 are allowable over the cited references.

5. **Claim 47.**

The Examiner rejects Claim 47 under 35 U.S.C. 103(a) as unpatentable over *Van den Heuvel*, *Sasuta*, and *Myers* in view of *Craport*.

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Van den Heuvel*, *Sasuta*, *Myers*, and *Craport*. Instead, the *Office Action* has merely stated that the teachings of one reference would improve the teachings of another reference. With regard to Claim 47 the *Office Action* states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of *Craport* to said method of *Van den Heuvel* in order to make it easier for the user to obtain and later select the best available wireless service.

Office Action, page 10.

Applicants respectfully submit that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the *Office Action*

has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claim 47 are allowable over the cited references.

6. Claims 22, 23, 68, and 92.

The Examiner rejects Claims 22, 23, 68, and 92 under 35 U.S.C. 103(a) as unpatentable over *Van den Heuvel*, *Myers*, and *Sasuta* in view of *Gerszberg*.

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Van den Heuvel*, *Myers*, *Sasuta*, and *Gerszberg*. Instead, the *Office Action* has merely stated that the teachings of one reference would improve the teachings of another reference. The *Office Action* states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of *Gerszberg* to said method of *Van den Heuvel* in order to make it easier for the user to obtain and select the best available wireless service.

Office Action, page 11.

Applicants respectfully submit that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the *Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Applicants therefore respectfully submit that Claims 22, 23, 68, and 92 are allowable over the cited references.


CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

No fees are believed to be due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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